

REMARKS

Applicants submit this Reply in response to the Final Office Action mailed April 21, 2009. Claims 21-40 are currently pending, of which claims 21 and 37 are independent. By this Response, Applicants have amended independent claims 21 and 37. Support for these claim amendments can be found in the originally-filed specification, at, for example, page 11, line 30 to page 12, line 7, and Fig. 1. No new matter has been added.

In the Final Office Action, the Examiner objected to the specification under 37 C.F.R. 1.75(d)(1) for purportedly failing to provide antecedent basis for the subject matter recited in claim 40.¹ In addition, the Examiner maintained the rejection of claims 21-28, 32, and 37-40 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,522,888 ("Garceran"). Finally, the Examiner maintained the rejection of claims 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Garceran in view of U.S. Patent Publication No. 20040156372 ("Hussa") and claims 33-36 were again rejected under 35 U.S.C. § 103(a) as being unpatentable over Garceran in view of U.S. Patent Publication No. 20030125046 ("Riley"). Applicants respectfully traverse all pending objections and rejections and request reconsideration of the application.

Objection to the Specification

The specification was objected to under 37 C.F.R. 1.75(d)(1) and M.P.E.P. § 608.01(o) for failing to provide antecedent basis for the claimed subject matter. In particular, regarding claim 40, the Final Office Action states that "applicant fails to

¹ The Final Office Action contains a number of statements reflecting characterizations of the Applicants' disclosure, including the claims, and the related art. Regardless of whether any such statement is specifically addressed herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

mention or clearly describe or define the scope of a computer-readable medium and instructions stored thereon in the specification." Final Office Action, p. 3. Applicants respectfully traverse this objection to the specification.

Applicants submit the M.P.E.P. does not require word for word correspondence with the specification of the application. The specification of the instant application provides support for the claimed "computer-readable medium." By way of a non-limiting example, Applicants point to page 12, lines 5-7 of the instant specification. Therefore, Applicants respectfully request withdrawal of the objection to the specification.

Rejections Under 35 U.S.C. § 102(e)

In the Reply filed on February 12, 2009, Applicants reasoned that Garceran does not anticipate claims 21-28, 32, and 37-40 because it does not disclose or suggest the "method for locating a terminal in a local wireless telecommunications network performed at a locating system . . . wherein the network comprises a plurality of base stations providing services on a plurality of coverage areas," as recited in then-pending claim 21, or the "processing system for locating a terminal in a local telecommunications network . . . wherein the network comprises a plurality of base stations that provide services on a plurality of coverage areas," as recited in then-pending claim 37. More specifically, Applicants explained that Garceran discloses a system in which the location of a wireless unit is determined by a wireless unit or a base station and is then transmitted to either the base station or an RF database, respectively. Applicants contrasted this disclosure of Garceran with then-pending independent claims 17 and 21, which each required that the location determination of the wireless unit be performed by an apparatus other than the wireless unit or the base station.

In the Final Office Action, the Examiner disagreed with Applicants' reasoning, apparently on the basis that the pending claims could be broadly interpreted to cover location determination that takes place at a non-serving, neighboring base station in the system for determining coverage in a wireless communication system of Garceran. See, e.g., Final Office Action, p. 2 ("Garceran teaches a locating system (neighboring base station, determining location, which is an apparatus different from the wireless unit and the serving base station))."

In this response, Applicants have amended independent claim 21 to clarify that the claimed locating method occurs at locating system that is physically separate from a wireless unit and all base stations, whether serving or non-serving, in contrast with the Examiner's broadly interpreted prior understanding of independent claim 21. More particularly, independent claim 21, as presently amended, recites, among other things, "[a] method for locating a terminal in a local wireless telecommunications network performed at a locating system that . . . is located remotely from the terminal and the plurality of base stations." Because amended independent claim 21 expressly requires that the performance of location determination to be "performed at a locating system that . . . is located remotely from the terminal and the plurality of base stations," Applicants submit that the Examiner cannot reasonably rely on the type of location determination that takes place at a non-serving, neighboring base station of Garceran. Applicants note that as is well known in the field of telecommunications, the claimed "plurality of base stations" encompasses both serving and non-serving base stations, as only one base station in a telecommunications network is considered to be a serving base station for each wireless unit, while all other base stations in the network are

considered to be non-serving base stations. The specification recognizes this terminology convention through its use of server access point and received access point. See, e.g., Specification, p. 13, lines 13-25.

Amended independent claim 37 likewise recites a processing system for location determination that is physically separate from a wireless unit, and all base stations, whether serving or non-serving. In particular, amended claim 37 calls for a combination including, for example, "[a] processing system . . . located remotely from the terminal and the plurality of base stations." Since Garceran only discloses that either a serving base station, a non-serving base station, or a wireless unit determines the location of the wireless unit, Applicants submit that the coverage determination system of Garceran cannot reasonably anticipate or render obvious "[a] processing system for locating a terminal in a local wireless telecommunications network . . . wherein the processing system is located remotely from the terminal and the plurality of base stations," as recited by independent claim 37.

As shown above, Garceran does not teach or suggest at least "[a] method for locating a terminal in a local wireless telecommunications network performed at a locating system that . . . is located remotely from the terminal and the plurality of base stations," as recited by independent claim 21 and "[a] processing system for locating a terminal in a local wireless telecommunications network . . . wherein the processing system is located remotely from the terminal and the plurality of base stations," as recited by independent claim 37. Because Garceran does not disclose every element of claims 21 and 37, it cannot anticipate these claims. Claims 22-28, 32, and 38-40 depend from one of amended independent claims 21 and 37, and are therefore

allowable for at least the same reasons. Thus, Applicants respectfully request the withdrawal of the rejection of claims 21-28, 32 and 37-40 under 35 U.S.C. § 102(e).

Rejections Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Garceran in view of Hussa and the rejection of claims 33-36 under 35 U.S.C. § 103(a) as being unpatentable over Garceran in view of Riley. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2142. In this application, a *prima facie* case of obviousness has not been established because the scope and content of the prior art have not been properly ascertained, see M.P.E.P. § 2141, and thus, a reason why the prior art would render obvious the claims has not been articulated.

Applicants have already established that Garceran does not teach or suggest at least the claimed "method for locating a terminal in a local wireless telecommunications network performed at a locating system that . . . is located remotely from the terminal and the plurality of base stations," as recited by amended independent claim 21 and as required by each of dependent claims 29-31 and 33-36. Moreover, the Final Office Action's application of Hussa and Riley fail to cure the above-noted deficiencies of Garceran.

More particularly, the Final Office Action alleges that

Hussa teaches transferring, to the terminal of the network (mobile based positioning), . . . , processing programs for performing at least one subset

of locating procedures . . . , and at least one subset of said plurality of configuration data base entries (base station coordinates) used by the transferred locating procedures . . . , whereby the location estimation is performed by the terminal and information about estimated position and estimation accuracy are transmitted from the terminal to a locating system upon every service request.

Final Office Action, p. 8 (internal citations omitted). The Final Office Action further alleges that "Hussa teaches the terminal performing signal measurement and calculates the location estimation." *Id.* at p. 9. Regarding Riley, the Office Action alleges that "Riley teaches estimates [sic] the position of the terminal corresponding to the barycenter (centroid) coordinates of the coverage area of said base station and an uncertainty value, the uncertainty value being defined by the distances from said barycenter to all points of the coverage area." *Id.* at p 11 (internal citations omitted).

Even assuming that the Final Office Action's characterizations of Hussa and Riley are correct, which Applicants do not concede, neither Hussa nor Riley teach or suggest the claimed "method for locating a terminal in a local wireless telecommunications network performed at a locating system that . . . is located remotely from the terminal and the plurality of base stations," as recited by amended independent claim 21 and as required by each of dependent claims 29-31 and 33-36. Accordingly, the cited references, taken either alone or in any reasonable combination, fail to teach or suggest all the recitations of claims 29-31 and 33-36. Thus, the Final Office Action has not articulated a reason why the claims would have been obvious to one of ordinary skill in the art and no *prima facie* case of obviousness has been established with respect to claims 29-31 and 33-36.

Conclusion

The preceding remarks are based solely on assertions presented in the final Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the final Office Action. The claims may include other subject matter that is not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other possible bases of patentability.

In view of the foregoing amendments and remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

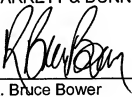
Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 21, 2009

By: _____


R. Bruce Bower
Reg. No. 37,099